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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,670	09/05/2003	Will Wood	40124/02301	1719

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EXAMINER	
PIERCE, JEREMY R	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/656,670	WOOD ET AL.	
	Examiner	Art Unit	
	Jeremy R. Pierce	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-19 and 22-24 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. 2/17/05, 12/29/03, 9/5/03
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-19 and 22-24, drawn to a fiber material, classified in class 428, subclass 361.

   II. Claims 20 and 21, drawn to a method of manufacturing a material, classified in class 264, subclass various.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed product does not require the particles to be mixed with the fiber material before forming into a fiber. The product may be made by mixing fibers with the particles after the fibers have already been formed, for example by attaching the particles in situ.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Oleg Kaplun on April 11, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-19 and

22-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20 and 21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

5. The information disclosure statement filed December 29, 2003 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the listed references are the same to those found on the information disclosure statement filed on September 5, 2003. The references need only be considered once. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-19 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "an effective malodor scavenging amount." How much is an effective amount?

Claim 1 recites "particles of zinc or similar reacting metal or metal alloy." The phrase "or similar reacting metal or metal alloy" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation "0.015 to 1 wt-%", and the claim also recites "0.015 to 0.20 wt-%" which is the narrower

statement of the range. Similarly, claim 11 recites the broad recitation "0.01 to 5 wt-%", and the claim also recites "0.1 to 1 wt-%" which is the narrower statement of the range.

Claim 24 recites "the facing layer" and "the absorbent layer." There is insufficient antecedent basis for either of these limitations.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-11, 13, 16-19, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Trinh et al. (U.S. Patent No. 5,429,628).

Trinh et al. disclose a material comprising fibers (column 6, lines 45-58) and particles of cyclodextrin dispersed throughout (Abstract). With regard to claims 2-7, the presence of zinc particles is not required in the claims. With regard to claim 8-10, the topsheet may be constructed of polypropylene fibers (column 10, lines 58-60) and the cyclodextrin may be dispersed throughout the topsheet (column 7, line 7). With regard to claim 11, see Example 7 (column 25, lines 8-20). With regard to claim 13, the cyclodextrin may comprise an alkyl ether group (column 15, lines 19-27). With regard to claim 16, the silyl ether group is not required in the claims. With regard to claim 17, the substrate may be spunbonded (column 10, line 45). With regard to claim 18, the cyclodextrin may be dispersed uniformly (column 14, lines 46). With regard to claim 19,

the absorbent core may be made of cellulosic fibers (column 7, lines 14-30) and the cyclodextrin may be dispersed in the core (column 7, line 6).

10. Claims 1-7, 13-16, 18, 19, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al. (U.S. Patent No. 5,776,842).

Wood et al. disclose a fibrous cellulosic web having cyclodextrin uniformly dispersed into the fiber (column 6, lines 60-67). With regard to claims 2-7, the presence of zinc particles is not required in the claims. With regard to claims 13-16, Wood et al. disclose the various claimed moieties (column 8, line 35 – column 10, line 62). With regard to claims 22-24, recitation of an intended use is not given patentable weight in the claim.

Claim Rejections - 35 USC § 102/103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claim 12 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Trinh et al.

Although Trinh et al. do not explicitly teach the limitation of low moisture content, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. cyclodextrin) and in the similar production steps (i.e. dispersed on fibers) used to produce the fabric. The

burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed low moisture content would obviously have been provided by the process disclosed by Trinh et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

13. Claim 12 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wood et al.

Although Wood et al. do not explicitly teach the limitation of low moisture content, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. cyclodextrin) and in the similar production steps (i.e. dispersed on fibers) used to produce the fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed low moisture content would obviously have been provided by the process disclosed by Wood et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 3,998,988 to Shimomai et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571)

272-1479. The examiner can normally be reached on Monday-Friday between 9am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP
Jeremy R. Pierce
April 12, 2005

ELIZABETH M. COLE
PRIMARY EXAMINER